

# Provisions on the Legal Protection of Topographies of Semiconductor Products, Law No. 70 of February 21, 1989\*

(as amended by Legislative Decree No. 198 of March 19, 1996)

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\* *Italian title:* Legge 21 febbraio 1989, n. 70. Norme per la tutela giuridica delle topografie dei prodotti a semiconduttori.

*Entry into force* (of amending Decree): April 15, 1996.

*Note:* Consolidation and translation by the International Bureau of WIPO on the basis of an English translation supplied by the Italian authorities.

For the Implementing Regulations, see *Industrial Property Laws and Treaties*, ITALY — Text 1-010.

\*\* Added by the International Bureau of WIPO.

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### *Definitions*

*Art. 1.—1.* “Semiconductor product” shall mean any finished or intermediate product:

- (a) consisting of a body of material which includes a layer of semiconducting material;
- (b) containing one or more layers composed of conducting, insulating or semiconducting material, arranged in accordance with a predetermined three-dimensional pattern;
- (c) intended to perform, exclusively or together with other functions, an electronic function.

2. “Topography” of a semiconductor product shall mean a series of related designs, however fixed or encoded:

- (a) representing the three-dimensional pattern of the layers of which a semiconductor product is composed;
- (b) in which series, each image reproduces in whole or in part a surface of the semiconductor product at any stage of its manufacture.

3. “Commercial exploitation” shall mean the sale, rental, leasing or any other method of commercial distribution, or an offer for these purposes. However, for the purposes of Article 4.5 and of Articles 5, 6, 7.1 and 3 and 18.2 and 3, “commercial exploitation” shall not include exploitation under conditions of confidentiality to the extent that no further distribution to third parties occurs, except where exploitation of a topography takes place under conditions of confidentiality required by a measure considered necessary for the protection of the essential interests of security which are connected with the production of or trade in arms, munitions and war material.

## *Subject of Protection*

*Art. 2.—*1. Exclusive rights may be enjoyed in topographies that are the result of creative intellectual effort on the part of their creators and that are not commonplace or ordinary in the semiconductor product industry.

2. Exclusive rights may also be enjoyed by topographies resulting from a combination of commonplace or ordinary elements where, taken as a whole, they satisfy the requirements of paragraph 1.

3. Protection afforded to topographies of semiconductor products shall not extend to any concept, process, system, technique or encoded information embodied in the topography.

## *Ownership*

*Art. 3.—*1. The exclusive rights under Article 2 shall apply in favor of the creator or his successors in title.

2. Where a topography has been created under a dependent work relationship, the right to protection shall apply in favor of the creator's employer, unless the employment contract provides to the contrary.

3. Where a topography has been created under a contract other than a contract of employment, the right to protection shall apply in favor of the party who has commissioned the topography, unless the contract provides to the contrary.

## *Content of Rights*

*Art. 4.—*1. The exclusive rights under Article 2 shall consist in the faculty of:

- (a) reproducing the topography in any manner or form whatsoever, either in whole or in part;
- (b) commercially exploiting, holding or distributing for the purpose of marketing or importing the topography or a semiconductor product in which the topography is embodied.

2. The rights under paragraph 1 shall be transferable and assignable.

3. The exclusive rights under paragraph 1 shall not extend to reproduction in the private sphere, for experimental purposes, for the purpose of teaching, analysis or evaluation of the topography or of the concepts, procedures, systems or techniques embodied in the topography itself.

4. The exclusive rights may not be exercised in respect of topographies created by others on the basis of an analysis or evaluation carried out in conformity with paragraph 3, where such topographies meet the requirements laid down in Article 2.

5. The rights under paragraph 1(b) shall expire in respect of the specific semiconductor product or the specific topography on first commercial exploitation anywhere in the world carried out by the owner or with his consent.

## *Recognition of Rights*

*Art. 5.—*1. The exclusive rights under Article 4 shall be recognized where:

- (a) the topography meets the requirements of Article 2;
- (b) the topography is registered in Italy or, where it has previously been commercially exploited anywhere in the world, its registration occurs within the period provided for in Article 7;
- (c) at the time of the first commercial exploitation of the topography or the filing of an application for its registration, the owner thereof is:
  - (1) a citizen or legal entity of Italy or of any other Member State of the European Union;
  - (2) a citizen or legal entity of another State party to the Agreement on Trade-Related Aspects of Intellectual Property Rights adopted in Marrakesh on April 15, 1994, or to a treaty on the protection of topographies to which Italy has acceded;
  - (3) a citizen or legal entity of any of the States referred to in items (1) and (2) above, or a person resident or having a real and effective establishment for the creation of topographies or the production of integrated circuits in the territory of any of the said States;
  - (4) a citizen or legal entity of another State to which Italy, even in the absence of bilateral international agreements on the protection of topographies, grants national treatment on the basis of reciprocity, provided that the protection granted by the law of that other State to Italian citizens or legal entities is comparable to the protection provided for in this Law.

### *Term of Protection*

*Art. 6.—*1. The exclusive rights under Article 4 shall expire 10 years after the earliest of the following dates:

- (a) the end of the calendar year in which the topography or the semiconductor product embodying the topography has been commercially exploited for the first time anywhere in the world;
- (b) the end of the calendar year in which the application for registration has been filed in due form.

### *Request for Registration*

*Art. 7.—*1. Topographies shall be protected on condition that registration is requested in Italy within a period of two years from the date of first commercial exploitation anywhere in the world.

2. Protection shall be afforded to topographies whose commercial exploitation has begun within the two years preceding the entry into force of this Law on condition that the application for registration is filed within 12 months as from the entry into force of this Law.

3. The right to request registration shall lapse on expiry of 15 years as from the date on which the topography is fixed or encoded for the first time if it has not been commercially exploited anywhere in the world during that period.

4. In procedures before the Italian Patent and Trademark Office, the applicant shall be deemed to have the right to registration and be entitled to exercise that right.

### *First Act of Commercial Exploitation*

*Art. 8.*—1. The date of the first act of commercial exploitation within the meaning of Article 1.3 shall be set out in a relevant written statement.

### *Administrative Provisions*

*Art. 9.*—1. The Italian Patent and Trademark Office shall provide the services relating to the subject matter regulated by this Law and shall ascertain whether the requirements of Article 2 have been met.

2. The Implementing Regulations under this Law shall be laid down by decree of the Minister for Industry, Trade and Handicrafts within a period of six months as from the date of entry into force of this Law.

### *Application for Registration*

*Art. 10.*—1. Article 91 of Royal Decree No. 1127 of June 29, 1939,<sup>1</sup> and Article 93 of that same Decree, as amended by Decree of the President of the Republic No. 338 of June 22, 1979, shall apply to the filing of applications for registration.

2. The application for registration shall be accompanied by drawings and documents required to identify the topography and to ascertain that the requirements of Article 2 have been met.

3. The drawings and documents attached to the application shall be published as of the date of registration. However, the applicant may request that publication of such drawings and documents be postponed until first commercial exploitation of the topography, for a maximum period of one year as from the date of registration.

4. The competent judicial authority may authorize disclosure of such material to parties in a dispute concerning the validity or infringement of exclusive rights under Articles 2 and 4.

### *Examination of Application for Registration*

*Art. 11.*—1. The Italian Patent and Trademark Office, after having ensured that the application is formally correct and that the conditions laid down by this Law have been met, shall effect registration of the topography and immediately issue a registration certificate to the person concerned.

2. The Implementing Regulations referred to in Article 9 shall lay down the particulars to be recorded in the Topography Register and on the registration certificate,

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<sup>1</sup> Law on Patents for Inventions, see *Industrial Property Laws and Treaties, ITALY* — Text 2-001.

together with the registration procedure and the procedure for appeals before the Board referred to in Article 13.

### *Refusal of Registration*

*Art. 12.*—1. Any decision by which the Italian Patent and Trademark Office refuses an application for registration or does not accept it in full shall be communicated to the applicant, who may appeal from such decision, within a period of 30 days as from the date of receiving the communication, to the Board referred to in Article 13.

### *Appeals Board*

*Art. 13.*—1. An appeal, within the meaning of and for the purposes set out in the Decree of the President of the Republic No. 1199 of November 24, 1971, filed before the Appeals Board referred to in Article 71 of Royal Decree No. 1127 of June 29, 1939, shall be admissible in respect of decisions taken by the Italian Patent and Trademark Office in the field regulated by this Law.

2. The final paragraph of Article 71 of the above-mentioned Royal Decree No. 1127 of 1939, added by Article 17 of Law No. 60 of February 14, 1987, shall be replaced by the following text:

....<sup>2</sup>

### *Fees*

*Art. 14.*—1. The following item *90ter* shall be inserted following No. *90bis* of Article VIII of the schedule of fees annexed to the Decree of the President of the Republic No. 641 of October 26, 1972, and its successive amendments and adjustments:

Acts Subject to Fees	Amount of Fees	Method of Payment
90ter. Registration certificates for topographies of semiconductor products:		
(1) Examination of application for registration	600,000	ordinary
(2) Registration	500,000	ordinary
(3) Entry of an act of transmission or constitution of warranty rights	50,000	ordinary

The provisions recorded in the notes relating to No. 90 shall be applicable by analogy.

The fee referred to in item (1) shall be paid prior to filing of the application and shall comprise the application for registration, the power of attorney where appropriate and examination of the application; in the event of refusal or withdrawal of the application, this fee shall not be refunded.

The fee referred to in item (2) shall be paid, at the request of the Italian Patent and Trademark Office, prior to the decision on registration, within 60 days of receipt of the request. If the fee has not been paid on expiry of that period, the Office shall reject the application.

### *Entries*

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<sup>2</sup> Amendment incorporated into the text of the Law on Patents for Inventions, see footnote 1.

*Art. 15.*—1. The provisions of Title VII of Royal Decree No. 1127 of June 29, 1939, concerning entries shall apply to the subject matter regulated by this Law.

2. The constitution and modification of rights in topographies of semiconductor products occurring prior to filing of the application for registration may be asserted in respect of third parties as from their respective dates, subject to those dates being certain.

### *Notice of Protection*

*Art. 16.*—1. The topography, the semiconductor product and its packaging may bear a notice comprised of:

- (a) the sign T within a circle;
- (b) the date of first commercial exploitation of the topography;
- (c) the name, denomination or sign of the owner of the right in the topography.

2. Such notice shall constitute evidence of registration of the topography, of claim to ownership of the topography or of the intention to apply for registration within the period laid down in Article 7.

3. The notice may not be affixed to products for which no application for registration has been filed within the period laid down in Article 7 or where such application has been definitively refused.

### *Infringing Acts*

*Art. 17.*—1. Any of the following acts carried out without the consent of the owner, even through an intermediary, shall constitute an act of infringement and violation of the exclusive rights under Articles 2 and 4:

- (a) reproduction of the topography in any manner and by any means whatsoever;
- (b) fixation by any means whatsoever of the topography in a semiconductor product;
- (c) utilization, importation and holding for the purposes of marketing, as also the marketing or distribution of a semiconductor product in which the topography is fixed.

### *Damages and Equitable Compensation*

*Art. 18.*—1. Any person who carries out an act referred to in Article 17 following registration of a topography or following a warning given by the person filing an application for registration, where such registration has been accepted, shall be required to make good the damages suffered by the owner of the exclusive rights in the topography.

2. Where an act referred to in paragraph 1 is carried out during the period of time between the first act of commercial exploitation of the semiconductor product bearing a notice of protection and registration of the topography, the person concerned shall only be required to pay equitable compensation to the owner of the registered topography.

3. Where the acts mentioned under subparagraphs (a) and (b) of Article 17 occur after the first commercial exploitation of a semiconductor product that does not bear a

notice of reserved rights, the owner of the registered topography is entitled to equitable remuneration and the infringer is entitled to the grant of a license on equitable terms for the continued exploitation of the topography within the limits of the use made of it prior to registration. Should the owner of the registration refuse to grant a contractual license, Articles 54<sup>quater</sup> and 54<sup>quinquies</sup> of Royal Decree No. 1127 of June 29, 1939, shall apply as appropriate.

### *Acquisition in Good Faith of Infringing Products*

*Art. 19.*—1. The importation, distribution, marketing or use of infringing semiconductor products carried out without knowing or without having any good reason to know of the existence of the exclusive rights under Article 4 shall not constitute acts of infringement.

2. In the situation provided for in paragraph 1 it shall be permissible to proceed with the activity undertaken within the limits of the contracts already made and existing stocks, but the owner of the exclusive rights is entitled to equitable remuneration as from the time at which he gives adequate notice to the *bona fide* acquirer that the topography in question has been unlawfully reproduced.

*2bis.* In the absence of agreement between the parties, the provisions of the second and third paragraphs of Article 50 of Royal Decree No. 1127 of June 29, 1939, as subsequently amended, shall apply to the calculation and manner of payment of the equitable remuneration adjusted to market prices.

### *Infringement Proceedings*

*Art. 20.*—1. Infringement proceedings for damages or equitable compensation may not be instituted prior to registration and may only be based on acts carried out during the three years preceding institution of such proceedings.

2. The provisions of Articles 74 to 89 of Royal Decree No. 1127 of June 29, 1939, shall apply, where appropriate, to the protection of rights deriving from topographies.

3. The administrative sanctions of two to 20 million lire and one to 10 million lire, respectively, shall apply in respect of the acts referred to in Articles 88 and 89 of the above-mentioned Royal Decree No. 1127 of 1939.

4. Instruments, apparatus and other accessories containing semiconductor products forming part of the structure or fittings of land vehicles, vessels, space vehicles or aircraft that temporarily or accidentally enter the territory, waters or air space of Italy shall not be liable to infringement proceedings or holding measures.

### *Holding Measures*

*Art. 21.*—1. The exclusive rights in registered topographies and in semiconductor products may be protected by the measures laid down in Chapter III of Title I of Book IV of the Code of Civil Procedure.

### *Annulment of Registration*

*Art. 22.*—1. A request for a judicial declaration to annul the registration of a topography may be submitted at any time and by any concerned person if any one of the



conditions under Articles 2, 5(c), 7, 8 and 10 has been omitted, has not been satisfied or if there exists no absolute certainty in respect of one of those conditions.

2. The decision to annul the registration shall be entered in the Topography Register.

### *Provisions Concerning Military and Public Interest*

*Art. 23.*—1. The provisions of the following Articles of Royal Decree No. 1127 of June 29, 1939, shall apply to topographies and semiconductor products in which they are embodied, where appropriate:

- (a) Articles 10, 10*bis* and 11. The administrative sanction laid down in the latter Article shall be set at an amount of from one to 10 million lire;
- (b) Articles 60, 61, 62, 63, 64 and 65.

### *Claim to Ownership of Registration*

*Art. 24.*—1. The provisions in the first and second paragraphs of Article 27*bis* of Royal Decree No. 1127 of June 29, 1939, shall apply to proceedings for ownership of a topography.

### *Financial Cover*

*Art. 25.*—1. The costs arising from implementation of this Law, estimated at 60 million lire a year for the activities undertaken by the Italian Patent and Trademark Office and at 85 million lire a year for the operation of the Board referred to in Article 13, shall be covered from the revenue referred to in Article 14.

2. The Minister of the Treasury shall be authorized to effect, by decree, the necessary modifications to the balance sheet.

This Law, bearing the seal of the State, shall be inserted in the Official Collection of Statutory Acts of the Italian Republic. All persons shall be required to comply with this Law and to ensure that it is complied with as a Law of the State.

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*(This text replaces the one previously published under the same code number).*